

Remarks

Claims 2, 4-35, 38-67 and 69 are currently pending in the Application.

Allowable Claims

Applicant acknowledges with gratitude the Examiner's indication of allowability as to Claims 2, 4-35, 38-40, 47-67 and 69.

Specification Amendment

As per the Supplemental Response dated July 7, 2006, the specification has been amended by adding a paragraph stating that the government has certain rights in this invention. The Examiner is respectfully requested to enter this amendment.

35 U.S.C. §102(e) Rejection

Claims 41-43 stand rejected under 35 U.S.C. §102(e) as being anticipated by Steensgaard-Madsen (U.S. Patent No. 6,348,884) ("Steensgaard" herein after). Applicant respectfully disagrees.

The Examiner is reminded that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 quoting *Verdegaal Bros. V. Union Oil Co, of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner is also reminded that "[the] identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant submits that the Examiner has not shown that Steensgaard teaches each and every element as set forth in the rejected claims. In particular:

Claim 41

A. Applicant submits that the Examiner has not shown that Steensgaard discloses, suggests or teaches, *inter alia*, the following features recited by Claim 41 of the present application:

“a tuning arrangement to **adjust a frequency spectrum of DAC errors**, thus shaping the DAC errors away from a desired frequency band” (emphasis added)

Referring to Steensgaard's Figure 14 reproduced below, the Examiner asserts that “a tuning arrangement” as recited in Claim 41 is disclosed by Steensgaard's box identified as “3-state.” See page 2, section 4 of the Official Action. Applicant respectfully traverses the Examiner's assertion.

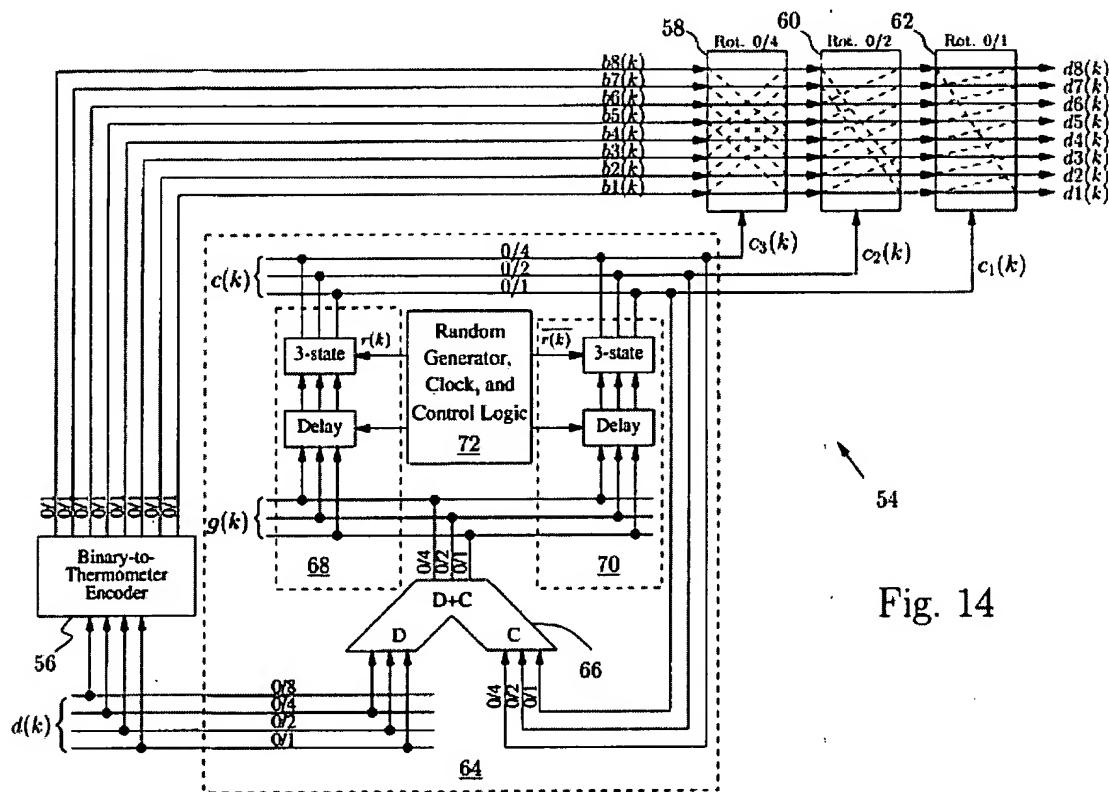


Fig. 14

Applicant submits that the boxes labeled “3-state” are part of structures “68” and “70.” See Steensgaard's Figure 14 above. According to Steensgaard, the structures “68” and “70” are delay elements that have 3-state outputs. See column 7, lines 58-59 of Steensgaard. Why does the Examiner believe that delay elements “68” and “70” teach “a tuning arrangement to **adjust a frequency spectrum of DAC errors**” (emphasis added) as recited in Claim 41? Where do Steensgaard's delay elements “68” and “70” “adjust a frequency spectrum of DAC errors” as recited in Claim 41? The Examiner appears to rely

on facts within his personal knowledge when asserting that the delay elements “68” and “70” “adjust a frequency spectrum of DAC errors” as recited in Claim 41. Applicant respectfully requests, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions. If the Examiner is relying on a prior art reference Applicant respectfully request that the Examiner cite the reference.

Applicant submits that Steensgaard’s delay elements “68” and “70,” as the name suggests, delay signals from the 3-bit adder “66” to demultiplexers “58, 60 and 62,” not adjust any frequency spectrum. If the Examiner does not agree, Applicant respectfully request that the Examiner comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Steensgaard teaches that the delay elements “68” and “70” are able to adjust frequency spectrum. Otherwise, Applicant respectfully requests that the assertion be withdrawn.

Furthermore, if the Examiner insists that the box labeled “3-state” is a “tuning arrangement” as recited in Claim 41, Applicant respectfully submits the following.

Steensgaard’s delay elements “68” and “70” also appear in Steensgaard’s Figures 15 and 17 wherein Steensgaard’s Figure 17, reproduced below” depicts “3-state” box “78” in more detail. Steensgaard’s “3-state” box “78” clearly contains switches “r(k).” See Steensgaard’s Figure 17 below. How exactly does the Examiner expect switches “r(k)” to “adjust a frequency spectrum of DAC errors” as recited in Claim 41?

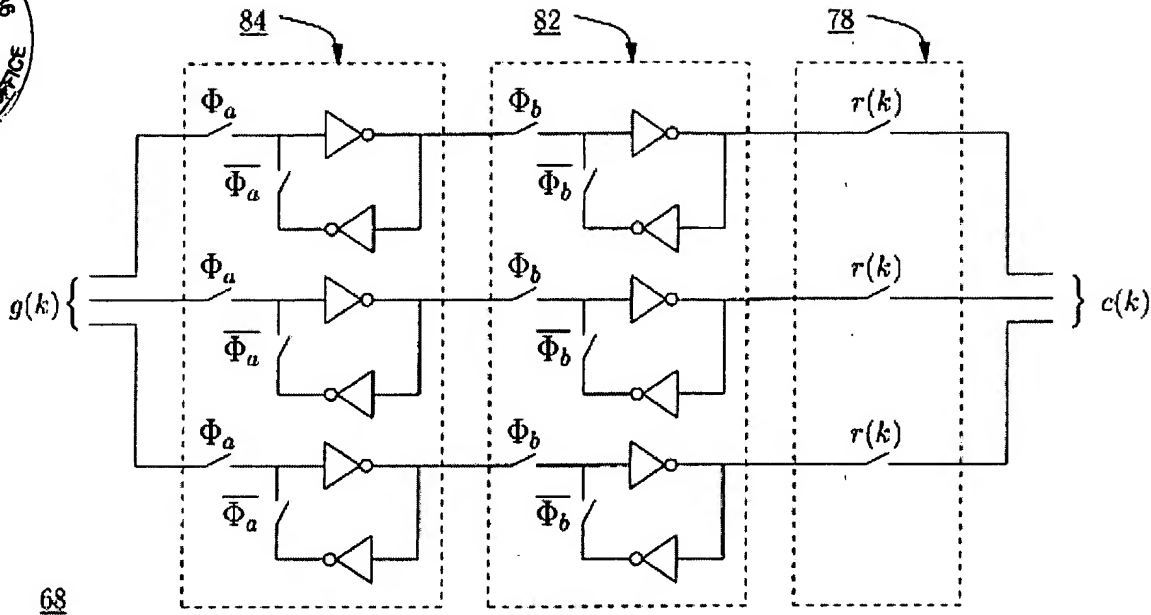


Fig. 17

Applicant submits that, unless the Examiner can demonstrate how Steensgaard's "3-state" is able to "adjust a frequency spectrum of DAC errors" as recited in Claim 41, Steensgaard does not teach, disclose or suggest "a tuning arrangement to adjust a frequency spectrum of DAC errors" as recited in Claim 41 and Claim 41 is patentable over Steensgaard and should be allowed by the Examiner. Claims 42-43, at least based on their dependency on Claim 41, are also believed to be patentable over Steensgaard.

B. Applicant submits that the Examiner has not shown that Steensgaard discloses, suggests or teaches, *inter alia*, the following features recited by Claim 41 of the present application:

"a control element comprising **at least three control element inputs**"
(emphasis added)

Referring to Steensgaard's Figure 14 reproduced above, the Examiner asserts that "a control element" as recited in Claim 41 is disclosed by Steensgaard's device "66." See page 2, section 4 of the Official Action. Applicant respectfully traverses the Examiner's

assertion.

According to Steensgaard, the device “66” is a 3-bit adder. See column 7, line 58 of Steensgaard. Applicant submits that in order for Steensgaard’s 3-bit adder “66” to operate properly it requires three inputs going into side “D” and three inputs going into side “C.” According to the Examiner, Steensgaard’s 3-bit adder “66” will still work if it has two inputs going into side “D” and only one input going into side “C.” See page 3, lines 1-3 of the Office Action. How does the Examiner expect Steensgaard’s 3-bit adder “66” to add two bits from side “D” with only one bit from side “C”? What would be the motivation in Steensgaard to add two bits with one bit? Once again the Examiner appears to rely on facts within his personal knowledge. Applicant respectfully requests, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions. If the Examiner is relying on a prior art reference Applicant respectfully request that the Examiner cite the reference.

Because Steensgaard’s 3-bit adder “66” requires three inputs going into side “D” and three inputs going into side “C” to operate properly, Steensgaard does not disclose, suggest or teach “a control element comprising **at least** three control element inputs” (emphasis added) as recited in Claim 41. Hence, Claim 41 is patentable over Steensgaard and should be allowed by the Examiner. Claims 42-43, at least based on their dependency on Claim 41, are also believed to be patentable over Steensgaard.

Claim 43

Applicant submits that the Examiner has not shown that Steensgaard discloses, suggests or teaches, *inter alia*, the following features recited by Claim 41 of the present application:

“the control element comprises a **delta-sigma modulator**” (emphasis added)

The Examiner asserts that the “control element” as recited in Claim 41 is disclosed by Steensgaard’s device “66.” See page 2, section 4 of the Official Action. Steensgaard’s

device “66” is a 3-bit adder. Since when do adders comprise “a delta-sigma modulator” as recited in Claim 41? Once again the Examiner appears to rely on facts within his personal knowledge. Applicant respectfully requests, under 37 C.F.R. § 1.104(d)(2), that the Examiner provide an Affidavit supporting the Examiner’s assertions that a 3-bit adders comprise “a delta-sigma modulator” as recited in Claim 41. If the Examiner is relying on a prior art reference Applicant respectfully request that the Examiner cite the reference.

Furthermore, Applicant submits that a word search of the Steensgaard reference revealed zero results for the term “delta-sigma modulator.” Applicant respectfully request that the Examiner comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Steensgaard teaches a “delta-sigma modulator” as recited in Claim 43. Otherwise, Applicant respectfully requests that the assertion be withdrawn.

35 U.S.C. §103(a) Rejection

Claims 44-46 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Steensgaard and further in view of Schreier (U.S. Publ. No. 2002/0105449).

Applicant submits that Claims 44-46, at least based on their dependency on Claim 41, are believed to be patentable over Steensgaard and Schreier, because there is no prima facie 35 USC 103(a) case based on Steensgaard, as shown above, and because the Examiner has not shown where Schreier discloses, teaches or suggests the features not found in Steensgaard.

* * *

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on

August 29, 2006
(Date of Deposit)

Susan Papp
(Name of Person Signing)

Susan Papp
(Signature)

August 29, 2006
(Date)

Respectfully submitted,

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